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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/781,033	02/09/2001	Donald P. Gibson	36.P290	1583

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EXAMINER

STAMBER, ERIC W

ART UNIT PAPER NUMBER

3622

DATE MAILED: 07/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/781,033

Applicant(s)

GIBSON ET AL.

Examiner

Stephen Gravini

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 February 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-52 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) 1-52 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-14, drawn to a method subcombination, classified in class 705, subclass 14.
- II. Claims 15-18, drawn to an apparatus subcombination, classified in class 705, subclass 1.
- III. Claims 19-32, drawn to a method subcombination, classified in class 705, subclass 10.
- IV. Claims 33-46, drawn to an apparatus subcombination, classified in class 709, subclass 239.
- V. Claims 47-51, drawn to a method subcombination, classified in class 725, subclass 23.
- VI. Claim 52, drawn to an apparatus subcombination, classified in class 706, subclass 11.

The inventions are distinct, each from the other because of the following reasons:

Inventions of groups I, III, & V and groups II, IV, & VI are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. In this case the process as claimed can be practiced by another materially different apparatus or by hand because the independently claimed server,

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program memory with processor, or computer is not a limitation in any of the independently claimed process. Because these independently claimed apparatus can be practice with an independent and distinct method, as independently claimed, the inventions are considered patentably distinct. (MPEP § 806.05(e)).

Inventions of group I and groups III & V are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention of group I has separate utility such as the steps of receiving, at a first location, image data retrieved from removable storage media and storing the image data at the first location then receiving and storing advertising information at the first location, at least some portion of the advertising information is unique to the first location and responsive to an output request, generating output of the image data, the output including the advertising information, wherein revenue is generated from the use of the advertising information is not a limitation found in any of the other independently claimed processes. These steps are considered independent and distinct and therefore are subject to a restriction requirement. See MPEP § 806.05(d).

Inventions of group II and groups IV & VI are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention of group IV has separate utility such as the feature of a server configured to save image data received from the receiving station to the image data store and to save received advertising information to the advertising data store, and to respond to a request to

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output the image data the server outputting the advertising information with the image data, wherein revenue is generated from the advertising information is not a limitation found in any of the other independently claimed apparatus. These steps are considered independent and distinct and therefore are subject to a restriction requirement. See MPEP § 806.05(d).

Inventions of group III and groups I & V are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention of group III has separate utility such as a generating step responsive to an output request, to generate output of the image data, the output including the advertising information, wherein revenue is generated from the use of the advertising information is not a limitation found in any of the other independently claimed processes. These steps are considered independent and distinct and therefore are subject to a restriction requirement. See MPEP § 806.05(d).

Inventions of group IV and groups II & VI are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention of group IV has separate utility such as a program memory for storing process steps executable to perform the steps of (1) receiving, at a first location, image data retrieved from removable storage media and storing the image data at the first location, (2) receiving and storing advertising information at the first location, at least some portion of the advertising information is unique to the first location, and (3) responsive to an output

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request, generating output of the image data, the output including the advertising information, wherein revenue is generated from the use of the advertising information, and a processor for executing the process steps stored in said program memory information is not a limitation found in any of the other independently claimed apparatus. These steps are considered independent and distinct and therefore are subject to a restriction requirement. See MPEP § 806.05(d).

Inventions of group V and groups I & III are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention of group V has separate utility such as displaying an image based on the image data and advertisement based on the advertising information in the service menu for offering to print the image data is not a limitation found in any of the other independently claimed processes. These steps are considered independent and distinct and therefore are subject to a restriction requirement. See MPEP § 806.05(d).

Inventions of group VI and groups II & IV are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention of group VI has separate utility such as a computer for receiving a request for displaying a service menu, and for sending, responsive to the request, the image data in the image database and the advertising information in the advertising database to display an image based on the image data and advertisement based on the advertising information in the service menu for offering to print the image data is not a limitation found in any of

the other independently claimed apparatus. These steps are considered independent and distinct and therefore are subject to a restriction requirement. See MPEP § 806.05(d).

Since the restriction is complex and examiner knows from past experience that an election will not be made by telephone, this written restriction is proper under MPEP 812.01.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen Gravini whose telephone number is 703 308 7570. The examiner can normally be reached on normal weekday business hours (east coast time).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric W Stamber can be reached on 703 305 8469. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

smg
June 23, 2004

Steve Gravini